

REMARKS

Claims 55 through 58 and 60 through 92 are pending in the application. Claims 55 through 58, 60 through 64, 73, 84, and 86 through 92 were rejected in the Office Action dated February 4, 2010. Withdrawn claim 65 has been canceled, and certain claims that depended from that claim have been amended accordingly. Reconsideration is respectfully requested.

I. Interview Summary

Applicants' representative appreciates the courtesy of the Examiner and the Supervising Primary Examiner in the telephonic interview conducted with respect to this application on Tuesday, April 27, 2010. Applicants' representative explained the background of the invention, and discussed with the Examiners the amendments made to claims 55, 87, and 89 that are shown above and described in more detail below.

II. Objection of Claim 89

Claim 89 has been amended to clarify its dependency on claim 87. Claim 89 is currently in condition for allowance and it is requested that the objection be withdrawn.

III. Rejection of Claims 55-58, 61-54, 87 and 89 and 90 under 35 U.S.C. § 102

Claims 55 through 58, 61 through 54, 87 and 89, and 90 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,249,963 (McGarrigle). The Examiner indicated that McGarrigle discloses the features of independent claims 55 and 87 of the present invention, including that the container is sealed with a breakable seal. The Examiner stated that, when the lid of the McGarrigle container is closed down on the base the container is sealed, and when the lid is removed from the base the seal is "broken." Applicants respectfully disagree.

McGarrigle does not disclose a seal of any kind and thus cannot anticipate the present invention. Furthermore, where an element is not explicitly present in a prior art reference, anticipation by inherency requires that the missing element be "necessarily present" in the prior art reference. (See, e.g. *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999)). Contrary to the suggestion of the Examiner, there is no indication that the container of McGarrigle inherently includes a seal of

any kind, much less that such a seal is “necessarily present.” McGarrigle, on the other hand, indicates that the purpose of the lid and container is to shield the light-curable compositions contained in the cavities from ambient light. See, e.g., Col. 2, ll. 45–47. It is not necessary that the lid form a “seal” as required by claims 55 and 87 of the present invention, in order to shield the contents of the container from ambient light.

Additionally, even if a seal were present in the container of McGarrigle, there is no reference to a “breakable seal,” either explicitly or inherently, as required by claims 55 and 87. “The breakable seal 5 as shown in Fig. 3 preferably provides besides an airtight sealing also a tamper-evident seal which indicates an intact and new unused package assembly.” (P. 14). Such a purpose of the seal would be defeated if the “breakable seal” could somehow be repeatedly broken and unbroken as suggested by the Examiner. Once the container is opened and the “breakable seal” has been broken, the container is subsequently sealed, if at all, in an alternative manner. For example, the container could be subsequently sealed by a friction fit between the lid and second end of the container when the lid is pushed onto the container resulting from an appendage created at the breakable seal during activation. Alternatively, the container may be sealed as indicated in the written description according to any other embodiment. It is inaccurate, therefore, to characterize the container of McGarrigle as including a “breakable seal” wherein the purported seal can be broken and unbroken indefinitely by removing and closing the lid.

Finally, independent claims 55 and 87 as amended above now recite that the seal is a breakable tamper-evident seal, which certainly is not shown in McGarrigle. Even if McGarrigle could be said to disclose some kind of seal, and even if opening of the McGarrigle device “breaks” that seal in some sense, a user cannot determine whether that seal is being broken for the first time. The present invention claims a breakable tamper-evident seal, which is of particular use in applications where the device is not intended to be used multiple times. Thus claims 55 and 87, and the claims that depend from them, are also patentable over McGarrigle because any seal that that reference could be said to disclose or suggest is not tamper-evident, and there is no reason that it would be. Claims 55 and 87, and the pending dependent claims, are therefore patentable under 35 U.S.C. § 102(b) over McGarrigle.

IV. Rejection of Claims 60, 73, 84, 86, and 91-92 Under 35 U.S.C. § 103(a)

Claims 60, 84, 86, and 91 through 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGarrigle in view of U.S. Patent No. 4,991,759 (Scharf). Claim 73 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McGarrigle in view of U.S. Patent No. 5,660, 273 (Discko, Jr.).

Each of these dependent claims includes the limitations of claim 55. Claim 55 is patentable over McGarrigle for the reasons discussed above, which are incorporated by reference here. Specifically, McGarrigle does not disclose or suggest a “breakable seal,” much less a “breakable tamper-evident seal,” as required by claim 55 of the present invention. Neither Scharf nor Discko, Jr. remedy the absence in the disclosure of McGarrigle of that feature, and thus do not render claim 55 obvious either standing alone or taken together with McGarrigle. Because the combination of McGarrigle with Scharf or Discko, Jr. do not render claim 55 obvious, the remaining claims depending on claim 55 cannot be rendered obvious by the above references. Reconsideration of the rejection is respectfully requested.

In regard to claims 91 and 92, the Examiner indicated that Scharf discloses a breakable seal that can be broken by pushing the lid in a direction substantially towards the container and further that Scharf discloses an appendage 38 is created at the breakable seal during activation providing a friction fit between the lid 14 and the second end of the container 16 when the lid is pushed onto the container 16. To the contrary, Scharf does not appear to disclose or suggest a “breakable seal.” Therefore, not only is there no reason to push downward on the lid after it reaches the top of the container, there is no “breakable seal” that will be broken if the lid is pushed towards the container as indicated by claim 91. The appendage 38 referred to by the Examiner is in fact a lip of the container and is not the result of activation of a breakable seal as required by claim 92. And because Scharf does not disclose a breakable seal, it also cannot disclose a “breakable tamper-evident seal” as is claimed in claim 87, nor does it suggest that feature. For these additional reasons, claims 91 and 92 are not obvious in light of McGarrigle and Scharf and the rejection should be withdrawn.

V. Rejection of Claim 88 under 35 U.S.C. § 103(a)

Claim 88 was rejected under 35 U.S.C. § 103(a) as unpatentable over McGarrigle in view of Scharf. The Examiner indicated that, when the tip of the cover 14 (at surface 38) reaches the top of the container 16, it creates a seal. That seal is later broken when the lid is pressed down further on the container.

Claim 88 includes the limitations of independent claim 87. Claim 87 is patentable over McGarrigle for the reasons discussed above. Specifically, McGarrigle does not disclose or suggest a “breakable tamper-evident seal” as required by claim 87 of the present invention. Scharf does nothing to remedy the absence in that disclosure of McGarrigle, and thus does not render claim 87 obvious either standing alone or together with McGarrigle. Because the combination of McGarrigle with Scharf does not render claim 87 obvious, claim 88 cannot be rendered obvious by the above references and it is respectfully requested that the rejection be reconsidered and withdrawn.

VI. Conclusion

For the reasons noted above, the pending claims are believed to be in condition for allowance, and reconsideration of the application is respectfully requested. If a telephonic conference would be useful in addressing any remaining matters in the application, the Examiner is invited to contact the Applicants’ undersigned representative at 651-736-4050.

Respectfully submitted,

April 28, 2010

Date

By: /Peter L. Olson/

Peter L. Olson, Reg. No.: 35,308

Telephone No.: 651-736-4050

Document No. 846516
Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833